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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,316

08/27/2003

Takeshi Namikata

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06/25/2007

FITZPATRICK CELLA HARPER & SCINTO

30 ROCKEFELLER PLAZA

NEW YORK, NY 10112

EXAMINER

QIN, YIXING

ART UNIT

PAPER NUMBER

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DELIVERY MODE

06/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/648,316	Applicant(s) NAMIKATA, TAKESHI	
	Examiner Yixing Qin	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention in claims 11-13 are directed to non-statutory subject matter. Claims 11-13 are rejected under 35 U.S.C. 101 because they are directed towards an abstract idea. Under the current 101 guidelines (specifically, page 30 "Annex I"), there are three 101 judicial exceptions – law of nature, natural phenomenon, and abstract idea. A program is simply a set of instructions and does not produce a physical transformation or a tangible result. The suggested correction is to amend the claims to "A computer-readable medium encoding a software control program...", like that of claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. Patent No. 6,493,462) in view of Murakawa (U.S. Patent No. 7,155,051)

Regarding claims 1, 8, 11, 14, Inoue discloses an image processing system having a host computer capable of communicatively connecting an image input-output device, the image processing system comprising:

a color space conversion unit for converting color space of an image which is an input-output target of the image input-output device into a predetermined color space; (Fig. 4, item S4-S6 – the RGB color space is converted to XYZ)

It does not explicitly disclose “a resolution conversion unit for converting resolution of the image which is the input-output target of the image input-output device into a predetermined resolution;”

However, Murakawa discloses in Fig. 4, item S11-S13 and column 4, lines 30-42 that the image is converted to a lower resolution for the purposes of easier detection.

Inoue and Murakawa are combinable because both are in the art of counterfeit detection.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used both a color space and resolution conversion technique to find counterfeit data.

The motivation would have been to make images created in various color space more uniform so that a counterfeit detection system can work more efficiently.

Therefore, it would have been obvious to combine Inoue and Murakawa to obtain the invention as specified.

a determination unit for determining the extent of a match between a particular image and a signal of an image converted into said predetermined color space and predetermined resolution; (Fig. 4, S8-S12 of Inoue and Fig. 4, S14-15 of Murakawa) and

an image processing control unit for controlling processing of said image based on the extent of the match as determined by the determination unit, (Fig. 4, S12)

the color space conversion unit, the resolution conversion unit, the determination unit and the image processing control unit being run on the host computer operating software (OS). (Fig. 1, item 1 of Murakawa)

Regarding claim 2, 9, 12, Inoue discloses the image processing system according to claim 1, wherein the image processing control unit generates a warning if the extent of the match meets or exceeds a predetermined threshold value. (Fig. 4, items S9-S11 and also Fig. 4, item S14, S15 of Murakawa. There are prestored values in which to compare the values of the image to.)

Regarding claim 4, Inoue discloses the image processing system according to claim 1, wherein the particular image is an original image whose reproduction is prohibited. (column 1, lines 60-65)

Regarding claims 5, 6, Inoue discloses the image processing system according to claim 1, further comprising: a driver for the image input-output device that runs on the host computer's software. (The secondary reference, Murakawa shows a computer connected to a printer and scanner. While not explicitly disclosed, drivers are well known in the art for the processing of data between various entities, such as between a computer and peripheral device.)

Regarding claim 7, Inoue discloses the image processing system according to claim 6, wherein said image input-output device either a scanner that scans an original image or a printer that outputs an image onto a recording medium. (abstract – a copier has a scanner and a printer portion)

II. Claims 3, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. Patent No. 6,493,462) in view of Murakawa (U.S. Patent No. 7,155,051) and further in view of Inoue et al (U.S. Patent No. 6,144,835 – “Inoue2”)

Regarding claim 3, 10, 13, the Inoue and Murakawa reference discloses methods for prevention reproduction of counterfeit material.

It does not explicitly disclose "a dialog box display unit for displaying a dialog box used for inputting instructions as to whether or not to continue with processing if the extent of the match meets or exceeds the predetermined threshold value;

a record archiving unit for archiving the operating record if an instruction is given to continue with processing in response to said dialog box; and

a discontinuance unit for discarding the image if an instruction is given to discontinue with processing in response to said dialog box."

However, Inoue2 discloses in Fig. 10, item S107 and 10, lines 34-50 that a third party confirmation may be needed for the reproduction of the bill. Inoue2 points out that a bill recognition signal is sent to the PC 60 for a third party to confirm. Since this information is readily available to the PC, it would have been obvious for one to record it using a well-known techniques such as storing related information in a database. Likewise, it is known to simply discard information that is not needed, if no confirmation is given to proceed with the copying.

All references are combinable because they are in the art of prohibition of copying of counterfeit material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a dialog box to warn users of potential illegal copying and to keep track of the actions taken.

The motivation would have been to give an user a warning prior to image reproduction and to keep track of situations of potential illegal activity.

Therefore, it would have been obvious to combine all three references to obtain the invention as specified.

Conclusion

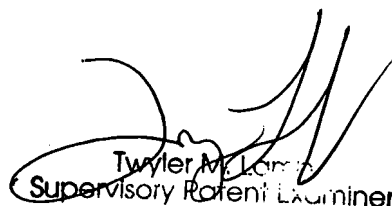
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



YQ



Twyler M. Lamb
Supervisory Patent Examiner